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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,737	12/15/2005	Timo Heinrich	Merck-3100	1689
23599 7590 08/18/2009 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER JARRELL, NOBLE E	
			ART UNIT 1624	PAPER NUMBER
			NOTIFICATION DATE 08/18/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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AUG 18 2009

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
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ARLINGTON VA 22201

In re Application of: :  
Heinrich et al. :  
Serial No.: 10/560,737 : PETITION DECISION  
Filed: December 15, 2005 :  
Attorney Docket No.: **Merck-3100** :

This is in response to the petition under 37 CFR § 1.181, filed June 18, 2009, requesting that the new non-final Office action be issued.

#### BACKGROUND

On August 7, 2008, the examiner issued a final rejection.

In response thereto, an Amendment After Final was presented on December 8, 2008.

On January 5, 2009, an Advisory Action was mailed indicating that the Amendment After Final would be entered but that various rejections of record were not overcome.

On January 6, 2009, a Notice of Appeal was filed, and on March 6, 2009, a Brief on Appeal was filed.

On June 9, 2009, subsequent to the filing of the Brief on Appeal, applicants received an Advisory Action, which indicated that "proposed amendments" will not be entered, as raising new issues, and indicating that a Brief on Appeal must be filed two months from the filing of the Notice of Appeal of January, 2009. The Advisory Action further indicated that the "Reply" of March 6, 2009 fails to place the application in condition for allowance. Also, the Advisory Action indicated that a prior rejection under 35 U.S.C. 102 is now being applied as a rejection under 35 U.S.C. 103.

#### DISCUSSION

The petition and the file history have been carefully considered.

Applicants' argue that "it is thus respectfully submitted that either the present Advisory Action misunderstands the status of the present case, in which amendments after final *were* entered, and a Brief on Appeal has *already* been filed, or, in the alternative, the Advisory Action attempts to impermissibly add a rejection to the application on appeal, without reopening of prosecution. It is submitted that, if it is desired to make a new rejection, prosecution *must* be reopened at this point, or if the new grounds of rejection meet the standards of MPEP § 1207.03, issued as part of an Examiner's answer giving applicants the opportunity to reopen prosecution."

Accordingly, applicants "petition for either reopening of prosecution and issuance of a non-final Office Action, or issuance of an Examiner's Answer which properly treats the Brief on Appeal on its merits".

Applicants' argument are well taken and found persuasive that the record is unclear.

Accordingly, applicants' petition for reopening of prosecution and issuance of a non-final Office Action is **DENIED**.

However, applicants' petition for issuance of an Examiner's Answer which properly treats the Brief on Appeal on its merits wherein the claims have been amended in accordance with the entry of the amendment after final of January 5, 2009 is **GRANTED**.

## **DECISION**

The petition is **GRANTED-IN-PART**.

This application is being returned to the examiner for consideration of the Appeal Brief of March 6, 2009 and the issuance of an Examiner's Answer.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Remy Yucel  
Director, Technology Center 1600